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Supreme Court, U.S.
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No. 95-127

In The
SUPREME COURT OF THE UNITED STATES
October Term, 1995

VAN KLASSENS, INC. and ROBERT LUKINGBEAL,
Petitioners,

v.

IMAGINEERING, INC.,
Respondent.

On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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QUESTIONS PRESENTED

Following a jury trial, the District Court entered judgment that Petitioners had infringed the trade dress of Respondent's line of WEATHEREND furniture under state and federal law. Finding that Petitioners, in bad faith, had traded on Respondent's good will, the jury awarded punitive damages under state law. Although vacating sanctions against Petitioners' counsel and remanding for a remittitur of the punitive amount, the Court of Appeals otherwise upheld the jury verdict in all relevant respects. Because Petitioners' framing of the questions is based on factual predicates rejected by the jury, Respondent submits that the issues before the Court are more properly framed as follows:

1. Whether this Court should reweigh the evidence and testimony presented at trial and enter a judgment notwithstanding the verdict on the following issues:
   a. the jury's finding that Respondent's trade dress is nonfunctional;
   b. the jury's finding that Respondent's trade dress is distinctive; and
   c. the jury's finding that Petitioners' willful imitation of respondent's trade dress is likely to cause confusion.
2. Whether this Court should overrule its prior holdings, and the prevailing rule in every Circuit to address the issue, that nonfunctional, distinctive trade dress is entitled to protection against confusingly similar imitations under both federal and state law.

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iv

RELEVANT STATUTES ix

STATEMENT OF THE CASE 1

SUMMARY OF THE ARGUMENT 2

ARGUMENT 3

I. BACKGROUND 3

A. Origin and Distinctiveness of Designs 4
B. Competitive Impact 14
C. Source Identification 15
D. Purchaser Confusion 16
E. Trade Dress 21

II. UNDER THE FACTS OF THIS CASE, THERE IS NO POSSIBLE CONFLICT BETWEEN PATENT AND TRADE DRESS LAW. 24

TABLE OF CONTENTS (Continued)

Page

III. UNDER THE FACTS OF THIS CASE, THERE IS NO POSSIBLE CONFLICT BETWEEN PATENT LAW AND STATE UNFAIR COMPETITION LAW 28

CONCLUSION 30

TABLE OF AUTHORITIES

Page

CASES

Aronson v. Quick Point Pencil Co., 440 U.S. 257 (1979) 28

Bauer Lamp Co. v. Shaffer, 941 F.2d 1165 (11th Cir. 1991) (per curiam) 4, 27

Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989) 28

Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513 (10th Cir. 1987) 27

Centaur Communications v. A/S/M Communications, 652 F. Supp. 1105 (S.D.N.Y. 1987), *aff'd*, 830 F.2d 1217 (2d Cir. 1987) 29

Clamp Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512 (9th Cir.), *cert. denied*, 493 U.S. 872 (1989) 27

Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964) 24, 28

In re D.C. Comics, Inc., 689 F.2d 1042 (C.C.P.A. 1982) 27

Emerson v. Davies, 8 Fed. Cas. 615 (C.C.D. Mass. 1845) (No. 4,436) 5

TABLE OF AUTHORITIES (Continued)

Page

Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts, 944 F.2d 1235 (6th Cir. 1991) *cert. denied*, 112 S. Ct. 3028 (1992) 26, 27

Flexitized, Inc. v. National Flexitized Corp., 335 F.2d 774 (2d Cir. 1964) 29

Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586 (C.C.P.A. 1973) 22

Harlequin Enters. Ltd. v. Gulf & Western Corp., 644 F.2d 946 (2d Cir. 1981) 9

Holiday Inns, Inc. v. 800 Reservation, Inc., 838 F. Supp. 1247 (E.D. Tenn. 1993) 16

Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78, 81 (3d Cir. 1982) 26

Imagineering, Inc. v. Van Klassens, Inc., 53 F.3d 1260 (Fed. Cir. 1995) ..... *passim*

Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844 (1982) 26

John Harland Co. v. Clark Checks, Inc., 711 F.2d 966 (11th Cir. 1983) 3

TABLE OF AUTHORITIES (Continued)

Page

Kohler Co. v. Moen Inc., 12 F.3d 632 (7th Cir. 1993) 25, 26

LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71 (2d Cir. 1985) 22, 26

Lincoln Restaurant Corp. v. Wolfey's Restaurant, Inc., 291 F.2d 302 (2d Cir. 1961) 29

Marathon Mfg. Co. v. Enerlite Prods. Corp., 767 F.2d 214 (5th Cir. 1985) 17

Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc., 221 F.2d 464 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955) 17, 30

In re Mogen David Wine Corp., 328 F.2d 925 (C.C.P.A. 1964) 26

Payless Shoesource, Inc. v. Reebok Int'l Ltd., 998 F.2d 985 (Fed. Cir. 1993) 18

Reader's Digest Ass'n v. Conservative Digest, Inc., 821 F.2d 800 (D.C. Cir. 1987) 27

RJR Foods, Inc. v. White Rock Corp., 603 F.2d 1058 (2d Cir. 1979) 9

TABLE OF AUTHORITIES (Continued)

Page

Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) 24

Shakespeare Co. v. Silstar Corp., 9 F.3d 1091 (4th Cir. 1993) *cert. denied*, 114 S. Ct. 2134 (1994) 27

T&T Mfg. Co. v. A.T. Cross Co., 449 F. Supp. 813 (D.R.I.), *aff'd*, 587 F.2d 533 (1st Cir. 1978), *cert. denied sub nom A.T. Cross Co. v. Quill Co.*, 441 U.S. 908 (1979) 16

Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir.) *cert. denied*, 429 U.S. 861 (1976) 27

Two Pesos, Inc. v. Taco Cabana, Inc., 112 S. Ct. 2753 (1992) 3, 24, 25, 26

W.T. Rogers v. Keene, 778 F.2d 334 (7th Cir. 1985) .. 26

Wallace Int'l Silversmiths v. Godinger Silver Art, 916 F.2d 76 (2d Cir. 1990) 4

Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995 (Fed. Cir. 1986). 15

TABLE OF AUTHORITIES (Continued)

Page

STATUTES

15 U.S.C. § 1114(1) 17

15 U.S.C. § 1117(a) 1

15 U.S.C. § 1125(a) 25, 27

OTHER

Rule 52(a), Fed. R. Civ. P. 11

RELEVANT STATUTES

Infringer Liable in Civil Action

15 U.S.C. § 1114. (1) Any person who shall, without the consent of the registrant —

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark any apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Monetary Relief

15 U.S.C. § 1117. (a) When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation under section 43(a), shall have been

established in any civil action arising under this Act, the plaintiff shall be entitled, subject to the provisions of sections 29 and 32 and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may, in its discretion, enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Unregistered Marks; False or Misleading Descriptions and Representations

15 U.S.C. § 1125. (a) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —

(1) is likely to cause confusion, or to cause mistake, or to

deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

STATEMENT OF THE CASE

Respondent, Imagineering, Inc. ("Imagineering"), has manufactured and sold WEATHEREND estate furniture since 1983. The pieces of furniture in the WEATHEREND line all share a nautical look, with wide slats, scooped seat boards, tapered arms, rounded edges, notched and curved legs, and angled backrests. Imagineering builds its WEATHEREND furniture from solid mahogany, using West System glue and Awlgrip paint. Imagineering advertises the WEATHEREND line aggressively, and numerous trade journals and other publications have given the line favorable reviews.

Robert Lukingbeal founded Van Klassens, Inc. (collectively "VK") in 1986. In 1987, VK began to make and to sell furniture described by the Court of Appeals to have a "striking similarity" to Imagineering's WEATHEREND line. *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1264 (Fed. Cir. 1995).

In January 1992, Imagineering sued VK, alleging, *inter alia*, trade dress infringement and false advertising under the federal Lanham Act and unfair competition under New York law. After a three week trial, the jury awarded Imagineering $860,000 in compensatory damages for willful trade dress infringement, false advertising, and unfair competition. The jury also awarded Imagineering $4 million in punitive damages. The District Court subsequently entered an order awarding Imagineering $250,000 in "enhanced" damages under 15 U.S.C. § 1117(a), $44,251.11 in sanctions against VK's counsel, $659,789.50 in attorneys fees, and $54,603.97 in taxable costs. The District Court also permanently enjoined VK from advertising or selling furniture "sufficiently similar" to be confused with Imagineering's WEATHEREND line of furniture.

VK appealed a number of issues to the Court of Appeals

for the Federal Circuit, including challenges to the jury's findings that Imagineering's trade dress was distinctive and that VK's furniture was confusingly similar to that of Imagineering. Without reference to Second Circuit authority placing the burden of proof on the issue on it, rather than Imagineering, VK also challenged the jury's finding that the WEATHEREND trade dress was nonfunctional. The Court of Appeals affirmed the jury's findings in all respects relevant to the Petition, concluding, *inter alia*, that: (1) "Taken together, the [relevant] factors **strongly support** the jury's finding of trade dress infringement," and; (2) "The jury properly awarded punitive damages for [VK's] willful conduct." 53 F.3d at 1265-66 (emphasis added).

SUMMARY OF THE ARGUMENT

In a fact-sensitive inquiry, VK ignores the facts. As a necessary consequence, its postulated legal issues are wholly hypothetical.

Based on the facts as developed and found by the jury at trial, and on the law applied in like circumstances by this Court and by every Circuit that has addressed the issues presented herein, the resolution below was not only correct, but routine. VK intentionally copied Imagineering's distinctive nonfunctional trade dress, creating actual confusion, to derive benefit from Imagineering's good will.

An injunction was thus here mandated to protect the public and preserve competition. There being a virtually unlimited number of alternative designs, **fair** competition was not possibly impaired.

If a design meets the requirements of the patent laws, it may be protected irrespective of other considerations to

promote invention. If a nonfunctional inherently distinctive design has come to identify one producer, and its appropriation will not harm other producers, an injunction will issue to the extent necessary to prevent confusion and preserve the reputation the owner. The two concepts are complimentary, not in conflict, and the latter was properly applied to the overwhelming proof adduced by Respondent at trial.

ARGUMENT

I. BACKGROUND

Trade dress "'involves the total image of a product and may include features such as size, shape, color ..., texture, graphics, or even particular sales techniques.'" *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2755 n.1 (1992) (quoting *John Harland Co. v. Clark Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). In this context, Imagineering alleged below that VK had intentionally encroached on Imagineering's "total image" by progressively copying the distinctive appearance of twelve items in its furniture collection[1] and by appropriating its total promotional program, unique to its line, that stressed, *inter alia*, the use of prime grade Honduras mahogany, Awlgrip paint, West System epoxy glue, boat building techniques and a nautical look. Tr. 33-34.[2] Imagineering alleged that VK had even adopted such details

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[1] During discovery, additional evidence of copying surfaced and the ultimate number of VK's implicated designs was twenty-two.

[2] References are to the ten thousand page Appendix before the Federal Circuit ("A___") and the two thousand page trial transcript ("Tr.___"), compressed into 504 Appendix pages, beginning at A3379.

as the "photographic composition of [Imagineering's] advertisements." *Id.*

VK asserted in defense the proposition repeated in its Petition (at 15, 32) that "'[i]t is a first principle of trademark law that an owner may not use a mark as a means of excluding competitors from a substantial market" and that Imagineering sought "protection, not for a precise expression of a decorative style, but for basic elements of a style that is part of the public domain." *Wallace Int'l Silversmiths v. Godinger Silver Art,* 916 F.2d 76, 79 (2d Cir. 1990). By their nature, therefore, Imagineering's claims and VK's defenses were predominantly fact-intensive, *see Bauer Lamp Co. v. Shaffer,* 941 F.2d 1165, 1170 (11th Cir. 1991), and the parties' respective views of the facts were in sharp dispute.

In now postulating, however, that this case exhibits irreconcilable tensions between federal patent and trade dress law, and between patent law and state unfair competition law (Petition at ii), VK **ignores** the total body of evidence below. Indeed, at multiple junctures, VK proceeds as if a trial had never occurred, and every assertion contained in VK's Petition is premised on a version of the facts that VK **unsuccessfully** argued to the jury. Examined in full context, the **facts** in the record negate the existence of **legal** conflicts.

A. Origin and Distinctiveness of Designs

For example, VK asserts in the Petition (at 5-7) and contended before the District Court that Imagineering's trade dress (i) consists merely of English style garden furniture (ii) that it copied from Hans Heistad and (iii) that is generic, and (iv) that VK independently reproduced from English and Scottish designs. The jury and the Court of Appeals, howev-

er, on the basis of overwhelming evidence to the contrary, adopted Imagineering's version of the facts:

First, neither Imagineering's designs, nor VK's replicas, are properly classified as English style garden furniture:

1. Imagineering's furniture is "uniquely American" in style with a "strong ... arts and crafts tradition to it."[3] Tr. 746, 834. It has "simple," "straight" lines (Tr. 761), "a clean classic look [and] beautiful proportions" (Tr. 833), and is used "for all the same purposes we use indoor furniture [-- for] living and dining areas outside." Tr. 837-38.

2. In England, by contrast, "there's a whole difference in attitude toward garden furniture.... [I]t rains a lot in England, ... and at the turn of the century, it wasn't fashionable to get a tan ... so they didn't spend a lot of time outdoors." Tr. 837-38. English garden furniture, therefore,

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[3] VK's attempt to argue that Imagineering's furniture must be generic because it fits within a style is the equivalent of asserting that, notwithstanding *Two Pesos*, a Mexican style restaurant cannot have a trade dress. It is true, of course, that:

> ... in literature, in science and in art, there are, and can be, few, if any, things which, in an abstract sense, are strictly new and original throughout. Every book ... borrows and must necessarily borrow and use much which was well known and used before.... Virgil borrowed much from Homer; ... and even Shakespeare and Milton ... would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days.

Emerson v. Davies, 8 Fed. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436). *West Side Story* is, however, a distinctive work notwithstanding a romantic style reflected three centuries earlier in *Romeo and Juliet*.

consisted principally of benches,[4] and the English garden bench was either a "very heavy [and] clunky" park bench (Tr. 842) or was "more ornate because it was used as a garden ornament as opposed to being a really functional piece of furniture the way outdoor furniture is considered in the United States." Tr. 841-42, 894-95.

The first essential premise of VK's defense was thus fundamentally erroneous.

Second, while a small number of Imagineering's first designs were inspired by Heistad's seminal works, even those designs were not copies of the Heistad originals:

1. As is readily apparent from photographs, the spacing of the slats, the seat boards, the relative proportions of the components, the feet and the aprons are all different. *See* A9917-19; *compare* A8-28; Tr. 65, 114, 878-79.

2. Even more to the point, the Heistad collection consisted of **only eight** items, **not one of which was at issue in this litigation.** Tr. 131-32. There was no rocker, chaise lounge, swing or quarter circle settee among the Heistad items, and the Heistad chairs and tables are very different from those that VK replicated from the Imagineering line. *Id.* Imagineering did not thus "copy" from Heistad any of the designs in dispute.[5]

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[4] As Ms. Lukingbeal admitted, there are no rockers, chaises, swings or side chairs in English garden furniture. Tr. 1087 ("They consider that bad form to rock"); *see also* Tr. 840-41.

[5] The debility of VK's "copying" defense is perhaps best reflected by its need to rely on ill-chosen words in early advertisements and unsolicited articles (not admitted for their truth), notwithstanding clear photographic evidence to the contrary and the unrebutted testimony of Imagineering's president that in later "advertising where we use the word 'reproduction,' we [correctly] qualify that by saying we make repro-

Third, and quite clearly, Imagineering's collection consists of inherently and highly distinctive designs:

1. When it came on the market in the 1980s, it was "unique" with a "fresh kind of look.... At that time there was nothing else like it." Tr. 761. The collection represented "a totally new look." Tr. 832. The tapered arms were "absolutely distinctive" and the "sleek finish" was "a major innovation ... in garden furniture." Tr. 848-49.

2. Perhaps the most cogent evidence that Imagineering's designs are "highly distinctive" (Tr. 158) is the extraordinary volume of media coverage (A5282-993) devoted to the collection (Tr. 156-89), describing it as "novel" (Tr. 159), "exclusiv[e]" (Tr. 164), "sculptural" (Tr. 166), "equated ... to a Rolls Royce" (Tr. 169), and "graceful" (Tr. 170) "outdoor classics" (Tr. 174). As the coverage reflects, Imagineering's pieces are owned by Kevin Costner, Stephen Spielberg, Dustin Hoffman, Bill Cosby, the Rockefellers, the Rothschilds and the Edsel Fords (Tr. 176), and Tiffany's has used models of the "furniture to decorate their windows in conjunction with their jewelry." Tr. 185-86, 378. The hundreds of displays in the nation's leading design publications signify that the line is "very distinctive because it's received so much media attention and that in some ways it's famous. People recognize our product, that it has a cohesive and overall look or appearance." Tr. 178-79.

3. Conclusively, VK's largest dealer, previously a dealer for Imagineering, testified that he "had not seen anything like [Imagineering]" (Tr. 916); that he "liked the

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ductions that surpass the originals in style and durability and construction." Tr. 338-39. Indeed, the whole Heisted issue was a diversion because in an eighty year history, the designs were never commercialized so as to be part of what VK insists is the public domain. Tr. 50, 110.

design, the feel of it, the niche" and that it embodied a unique feel in and of itself. Tr. 918. He had himself advertised Imagineering's furniture as "incomparable." Tr. 959-60. VK, on the other hand, advertised that its **copied designs** were "distinctive." A10072; Tr. 1612 ("Our furniture is as comfortable and durable as it is elegant and attractive. It is distinctive furniture that you'll be proud to own for years to come."). As Mr. Lukingbeal testified, VK's furniture "was different from anything that [Ms. Lukingbeal] had seen, at any rate, in the United States.... [I]t was a distinctly different type of furniture from what she was aware of...." Tr. 1615.
VK's repeated insistence, therefore, that Imagineering's designs are nondistinctive and generic is effectively rebutted by the words of its own principal witnesses.

Finally, the true provenance of VK's designs is unequivocally clear:

1. First, given the enormous editorial coverage and extensive, full-page advertising devoted to Imagineering's furniture in the design and garden publications which Mrs. Lukingbeal acknowledged reading (Tr. 229-30),[6] VK's asser-

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[6] Between 1984 and trial, Imagineering expended more than $1.3 million on advertising (Tr. 191-93), each example featuring pieces in Imagineering's collection. A4713-5281. The advertisements have appeared in "Southern Accents, Interior Design, Landscape Architecture, New England Monthly, Metropolitan Home, Progressive Architecture, Design Times, Garden Design, American Horticulture, Mid Atlantic Monthly, The New York Times Magazine, House and Garden, Metropolis, Horticulture, Architectural Record, Historic Preservation, Country, Food and Wine, Gourmet, Maine Times, The Village Advocate, MIT Places, American Society of Interior Designers, Interior Designers of America" (Tr. 194), and Imagineering's advertising "has been very successful.... The publications that we advertise in very often put together survey material [asking readers if they] remember an ad ... and we have always scored very high in the surveys that have been done. I know in Architectural Record

tion that it was unfamiliar with Imagineering's collection when it decided to enter the garden furniture business is "highly unlikely," if not "[im]possible." Tr. 180, 831 ("you couldn't open a magazine on gardens or home design without seeing an ad or an article").

2. It is obvious from the record that VK, at the very least, had Imagineering's 1985 brochure at the time VK developed its designs. The brochure, **with the last page removed to delete the dated copyright notice**, was found in the files of the attorney VK consulted in 1987. Tr. 243-46, 1568; Px. 102. If Mr. Lukingbeal, as he testified, had first requested and received a brochure in July, 1987, he would have gotten Imagineering's **1986 publication**. Tr. 249-50.

3. It is also obvious that VK had the 1985 Smith & Hawken catalog featuring Imagineering's line. Tr. 197-200. The catalog (Px. 259) depicted an early "variation" of Imagineering's "Weatherend" chair with a shallow scoop on the front leg, a treatment which VK duplicated with "very few differences" (Tr. 198-99), and VK's initial offerings were "very similar to the [Imagineering's] pieces that had been advertised in Smith & Hawken." Tr. 205-06.

4. Even VK necessarily admits (Tr. 1498) that it had Imagineering's catalog in 1989 when, notwithstanding clear notice of Imagineering's rights (Tr. 198-99), it progressively extended its infringement to Imagineering's rocker, chaise lounges and armless chair. Tr. 213.

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in 1992, we were among the top ten...." Tr. 195-96. Such evidence, together with the unparalleled media coverage, *Harlequin Enters. Ltd. v. Gulf & Western Corp.*, 644 F.2d 946, 950 (2d Cir. 1981), and proof of intentional copying, *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1060 (2d Cir. 1979), establish that apart from their inherent distinctiveness, Imagineering's designs have acquired secondary meaning.

5. In addition, when, as the "final straw" (Tr. 218), VK designed its quarter-circle settee in 1991, VK had the blueprints for Imagineering's quarter-circle settee from a John Wayne Airport bid package. Tr. 214, 216-17.

6. Nonetheless, VK's principals adamantly denied initially even knowing about, or later being influenced by Imagineering's designs. *See* Tr. 1497-98. With respect, for example, to the quarter-circle settee, Mr. Lukingbeal testified that:

> it had nothing to do with the bloody John Wayne Airport. All it had to do with was Cawdor [Castle] up in Scotland, which [we visited in 1964 and which] clearly had very nice curved pieces. And to the best of our knowledge, that has sat up at Cawdor for umpteen years before there was either your client or us, a long time and absolutely nothing wrong.

Tr. 1601; *see also* 1098, 1100, 1599. Ms. Lukingbeal, who could not recollect even recent events, *e.g.*, how she had gotten an Imagineering catalog (Tr. 1129), the name of VK's attorney (Tr. 1130), her prior residence address (*id.*), which pieces VK had first produced (Tr. 1032), or the name of VK's photographer (*id.*), nonetheless clearly remembered with her husband that "we had seen [a curved bench in 1964] there when we had gone up to Inverness and out to see [Cawdor] castle." Tr. 1082.

7. At the time the Lukingbeals claim to have visited Cawdor Castle, they had "no idea" of going into the furniture business and took no pictures (Tr. 1602-03, *see also* Tr. 1111-12, 1131), and their account of having created a design in 1991 from twenty-five year old recollections was, on its face, "pretty ridiculous." Tr. 462-63.

8. More fundamentally, Cawdor Castle was **not open to the public in 1964.** Tr. 1752-53. As the trial judge thus observed at a post-trial hearing on March 30, 1994:

> at the trial, Ms. Lukingbeal revealed with that totally unbelievable story about having seen these things in Scotland that she and Mr. Lukingbeal were involved in a ... fabricated story.... That story was ... revealed as being false ..., on the trial there was evidence that it was absolutely false....

A8170. The Cawdor Castle story was obviously concocted from a **March 1991** article in House Beautiful. A4061-62; Tr. 1082.[7]

9. In point of fact, most dimensions of VK's chairs and settees were within a half inch of Imagineering's (Tr. 425), the coincidental likelihood of which was "impossible ... -- it would be a miracle." Tr. 432-33. Even a cursory visual inspection of the quarter circle settees that were exhibited to the jury (Pxs. 572-73) revealed that VK had simulated Imagineering's measurements, curvatures, sizing and placement of slats, unique arm configuration, front leg scoop and finish. As Mr. Harper, Imagineering's construction foreman, testified, it "didn't take much to figure out that someone had our drawings and copied them." Tr. 438-39.

10. VK's collection "was obviously and blatantly a copy of [Imagineering's] furniture." Tr. 747-48.

> [I]t's possible that two people could design the same looking sofa or rocking chair, but it's not possible when a catalog imitates the entire collection. Every piece of [Imagineering] furniture appears in,

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[7] It is thus here particularly appropriate that "due regard ... be given to the opportunity of the [fact finder] to judge of the credibility of the witnesses." *See* Rule 52(a), Fed.R.Civ.P.

> mostly in that VK catalog. And even the photographs are similar. Even the typeface used is similar.

Id. ("there is a ... very strong lifting of the core of the collection in the [VK] catalog"). The designs are "so strikingly similar ... that it was very confusing." Tr. 858.

11. John Saladino, a nationally renown expert in interior and furniture design (Tr. 731-36), with extensive knowledge of the Imagineering line, could not correctly select the originals from the copies, **even displayed side-by-side**, from a distance of twelve feet. Tr. 767-73. He could not do so even from a distance of **three feet**. Tr. 816-19. "[A]t a distance," even a professional "wouldn't be able to tell the difference" between the two collections. Tr. 858. "Without seeing them side by side, it's difficult [even for one familiar with the lines] to tell which is which." Tr. 898.[8]

12. Even beyond the appropriation of Imagineering's designs, the enormity of VK's taking from Imagineering's "total image" was virtually without limit:

a. Before Imagineering, no one had "advertise[d] a table upside down." Tr. 126, 130. VK adopted the same format, even photographing the underside of its product from the same angle. A10087.

b. Indeed, VK "elected to photograph [its entire line] and advertise it in the exact same format as [Imagineering's] photographs that were put together in 1986." Tr. 148, 228.

c. VK "elected to use a [similar] rectangular

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[8] Both Imagineering's President and its Executive Vice President testified that the minor differences that did exist were dictated by cost considerations, allowing VK to compete even more unfairly with Imagineering. Tr. 377, 81-83.

plate ... made out of brass, and they affix it in the same place we affix our brass tags." Tr. 154.

d. At the suggestion of the Mayor of Rockland, Maine (Tr. 334), Imagineering used in its 1985 catalog (A9920-33) the unusual British term "spanner," in lieu of the American term "wrench," to "convey a certain feel for the [its] furniture." Tr. 126, 237. VK used "spanner wrench" (Tr. 238), the equivalent of "wrench wrench." Tr. 334.

e. VK, quartered in Tennessee, adopted Maine-based Imagineering's references to "boat building" techniques (A10072), and touted the "nautical look" of the curved and tapered top rail of its low-back chair. Tr. 231.

f. For its rocking chair, VK adopted Imagineering's emphasis on a "safe rocking zone." Tr. 232-33.

g. Like Imagineering, VK also stressed the use of solid Honduras mahogany, West System glue, Awlgrip paint and epoxy applied to the feet of all pieces (Tr. 234-36), none of the latter three of which had before been used or featured by a furniture concern. Tr. 87, 89, 357, 396-97, 399.

h. In the 1985 Smith & Hawken catalog, Imagineering's swing was promoted with the phrase "Did you ever sit in a wooden swing on a summer eve under an elm and watch the fireflies?" VK adopted the phrase, "If you ever spent a June evening on a porch swing watching lightening bugs...." Tr. 241-42.

The probability that VK independently arrived at furniture designs, and independently created a promotional program, substantially identical in multiple, material respects to those earlier created by Imagineering, is obviously nonexistent.

B. Competitive Impact

VK argued to the jury, as it does repeatedly in its Petition (at 5, 13, 25-26, 32) that affording protection to Imagineering's designs would "impede competition" and afford to Imagineering a "patent-like monopoly." The jury and the Court of Appeals, however, were presented with **overwhelming** evidence to the contrary.

VK itself had manufactured Chartwell and Chippendale garden pieces that are of a "very different type of design" (Tr. 142-43), and there is a virtually unlimited number of other "designs available in the marketplace." Tr. 170, 183-84, 243, Tr. 758. Summit, Brandywine, Barlow-Tyrie, British American, Lister, Richardson Allen and many others produce highly marketable, "extremely well accepted" designs that look nothing like Imagineering's. Tr. 842-58; *see also* Tr. 379-80. In total, there were more than **forty** third-party catalogs in the record (*see* Px. 259, 280, 286.1, 579.1, 593, 1000.1, 1000.2, 1000.5, 1000.6, 1000.9, 1000.11, 1000.24, 1000.27, 1000.32, 1000.35; Dx. EF, GT, OT, OU, OV, OW, OX, OY, PA, PB, PC, XN, and CCJ.1 (a collective exhibit of fourteen catalogs))[9] of furniture that did not "even come close to infringing on [Imagineering's] design." Tr. 373-74. In, therefore, a field where even a single design change can represent "a major departure from the appearance of [Imagineering's]

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[9] It is instructive that to show Imagineering's designs were "common," VK offered **the same catalogs** that were offered by Imagineering to show **noninfringing alternatives**. Tr. 842-58. Confronted not only with the catalogs, but with such a courtroom full of furniture that the trial court was prompted to remark, "if you bring any more ... in here we'll have to have a sale" (Tr. 458), the jury clearly opted for Imagineering's characterization.

product line" (Tr. 308-09), VK clearly "didn't have to knock off" Imagineering to produce a competitive or marketable product. Tr. 859.

The jury necessarily concluded, to paraphrase the *Wallace* decision repeatedly cited in VK's Petition (at 15, 31, 32), that Imagineering had shown "secondary meaning [and inherent distinctiveness] in a **precise expression** of [American] style" furniture and that because "numerous alternative ... designs [were] available to competitors," VK should be "excluded from using an identical or virtually identical design." 916 F.2d at 81 (emphasis supplied). Without, of course, investing the enormous sums required for original designs, quality manufacturing methods and extensive marketing (Tr. 358, 374-75), VK would like to "piggyback" on Imagineering's efforts. Tr. 821. That, however, is not competition; it is unfair competition, and there is no legally protectable, **competitive** interest in permitting misappropriation of another's good will:

> One who elects to build a business on a product found to infringe cannot be heard to complain if an injunction against continuing infringement destroys the business elected.

Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995, 1003 n.12 (Fed. Cir. 1986).

C. Source Identification

VK insisted below, and here asserts (Petition at 7, 20, 22), that it "plainly marked its ... furniture with its own source-indicating trademark"; that "both parties clearly label their products." As, however, for the **small** rectangular nameplates located on the **back, underside rails of its pieces**, even

VK's counsel:

> had to flip the chairs over to show the jury so he could read the tags. It's not something you can just walk up to and see. You have to actually move, physically move the furniture to read the tags.

Tr. 386. With respect to Imagineering's nameplates, the following colloquy transpired (Tr. 1052-53):

> THE COURT: The rectangular nameplate is on your items?
>
> MS GULLOTTI: Yes, sir.
>
> THE COURT: Where? It's not visible, is it.
>
> MS GULLOTTI: It is if you tip the chair upside down.

Far more prominent signage did not suffice in *Two Pesos,* and it is generally recognized that "[d]isplay of the infringer's name ... is least likely to avoid confusion when the infringement involves the design of the item itself and not the package or the trade name." *T&T Mfg. Co. v. A.T. Cross Co.,* 449 F. Supp. 813, 820-22 (D.R.I.), *aff'd,* 587 F.2d 533 (1st Cir.), *cert. denied,* 441 U.S. 908 (1978); *see also Holiday Inns, Inc. v. 800 Reserv., Inc.,* 838 F. Supp. 1247, 1255 (E.D. Tenn. 1993) (unfair competition despite disclaimer by defendants immediately upon contact by consumers).

D. Purchaser Confusion

As if it were dispositive, VK emphasized to the jury, and iterates in the Petition (at 7, 31 n.13), the absence of evidence that a consumer had actually purchased its furniture believing that it came from Imagineering. VK argues in the Petition (at 21-22) that "consumers have a right to be protected from *confusion as to source* and this is the focus of the Lanham Act ..., the focus is on the protection of consumers, not the

protection of producers as an incentive to product innovation."

It is, however, hornbook law that:

> [A plaintiff] need not prove actual confusion on the part of actual consumers. Prior to 1962, § 32(1)(a) of the Lanham Act, 15 U.S.C. § 1114(1) required confusion, mistake or deception by "purchasers as to the source or origin of such goods or services." In 1962, the quoted words were deleted, **specifically to allow any kind of confusion in support of a trademark infringement action.**

Marathon Mfg. Co. v. Enerlite Prods. Corp., 767 F.2d 214, 221 (5th Cir. 1985) (citations omitted; emphasis added). **Any** type of confusion or mistake can trigger liability under the Lanham Act. *See, e.g., Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955).

In this framework, there was an overwhelming body of evidence as to actual confusion of Imagineering's own employees (Tr. 225-26, 431, 980), its independent agents (Tr. 226, 984-85), its expert witnesses (Tr. 750, 896-97) and its customers (Tr. 643-44, 648-49). As even Mr. Lukingbeal testified (Tr. 1560):

> A. In the spring, summer, rather, 1987, after we started to advertise, we received a lot of calls from former Weatherend dealers and former Weatherend reps. As a matter of fact, one person called -- a man called who claimed to represent Weatherend in Virginia who saw our ad and called us and wondered if he might sell his furniture through us. He thought we were a dealer.
>
> Q. For Weatherend?
>
> A. Yes, ma'am.
>
> Q. He thought you were a dealer for Weatherend?

A. That's the impression he conveyed, yes, ma'am.[10]

In this case, Imagineering's particular concern was with **post-sale confusion**: that "the consumer may attribute any perceived inferior quality of [defendants' product in the field to plaintiff], thus damaging [plaintiff's] reputation and image." *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985, 989 (Fed. Cir. 1993). Major components of VK's quarter-circle settee were constructed not of Honduras mahogany, an expensive, stable, rot-resistant wood that is particularly suitable for outdoor use, but of cheap luan bending ply, a non-durable "garbage wood" with "very light resistance to decay." Tr. 396, 443-44 (the defect is "not repairable" and the product is "bound for the dumpster"), 555 ("this material simply isn't appropriate for furniture in any case, let alone exterior furniture, let alone expensive exterior furniture"), 592-93, 598-99. The material "delaminated" -- literally came apart -- during testing (Tr. 593-94),[11] and seat boards had fractures hidden by paint. Tr. 447-48.

Overall, VK's construction techniques were "quite amateur." Tr. 424. Underneath the surface, the "joinery was absolutely terrible." Tr. 426. Dissection of VK's chairs revealed "holes drilled quite oversize, ... extremely poor

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[10] As the Court of Appeals noted, "[b]ecause dealers and experts are more sophisticated about the origins and sources of product lines than average consumers, their confusion is 'highly probative on the question of whether a likelihood of confusion exists.'" 53 F.3d at 1265 (citation omitted).

[11] Mr. Lukingbeal testified on direct that he discontinued using luan ply in July, 1992. Tr. 1531. On cross-examination, however, he conceded that VK was still using the material in the summer immediately preceding trial. Tr. 1575. Significantly, VK concealed such use from both Imagineering's (Tr. 538, 554, 580), and its own expert. Tr. 1295.

tolerance, lots of glue voids" (Tr. 428), and while the gaps in joints were "concealed under paint" (Tr. 534), components "fell right apart on me." Tr. 430. With respect to one joint, Thomas Moser, a nationally recognized manufacturer of hand-crafted furniture (Tr. 502-14), testified:

> We call this a dime fit; that is to say, you can drop a dime through it.... there's an opportunity for moisture to penetrate. And that moisture entering into a dowel is a time bomb. It's only a matter of time that joint is going to fail.

Tr. 550-51.[12] "Fine furniture simply is not made that way." Tr. 553-55. "If you don't have close fitting parts you'll have a piece of furniture that will fall apart." Tr. 406, 543.[13]

VK's equipment, however, simply was "not capable of consistent ... joinery" (Tr. 518-19): "jigs, fixtures and other techniques to reproduce components were less than professional" (Tr. 520); they were "amateur ... not industrial, professional or engineered for repetitive work." Tr. 521-22, 532-33. As for the finish, "the [VK] bench seemed very well spray painted where it showed, but in many critical locations ... hidden from view there was no finish. It was sort of a out of sight, out of mind ... approach to protecting the wood ...." Tr. 595-96. "[T]here were lots of bare wood areas where the finish is going to fail real quick." Tr. 426. There was thus "absolutely no comparison" in quality between Imagineering and VK. Tr. 454.

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[12] As VK's expert testified, "[a] good fit is ... suppose to be perfectly airtight" (Tr. 1278), and he conceded as to VK's joints, "[m]oisture could get in eventually." Tr. 1277.

[13] VK's dealers, of course, were given samples of tight-fitting joints as (mis)representative of its quality. Tr. 930-31.

While, however, there was irrefutable evidence that VK's furniture was substantially inferior, "just looking at the benches ..., there is a very good paint job on [the visible surfaces]" so a purchaser could believe they were comparable. Tr. 751-52. As Imagineering's production manager thus testified at trial (Tr. 449-51):

> Q. What was your impression of the overall quality in the VK settees?
>
> A. To me, there's no comparison at all. I would be ashamed to build a piece of furniture like that.
>
> Q. Do they look the same?
>
> A. From the outside yes, they do.
>
> Q. Do you think one in the market could substitute a VK for Weatherend and not realize what they've purchased?
>
> A. Sure.[14]
>
> * * *
>
> Q. [Y]ou testified you didn't believe [VK's furniture] would last as long as [Imagineering's] because of the Luan mahogany, is that correct?
>
> A. Right. It's not going to last very long at all, no.
>
> Q. What happens when the settee deteriorates in the field?
>
> A. When that settee, VK deteriorates in the field the

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[14] VK's agents and others not only could (Tr. 751) but, in fact, did substitute its furniture for Imagineering's (Tr. 753-54, 805-06, 954), requesting, *e.g.*, furniture from VK "similar to [Imagineering] as shown on attached cut sheet," an Imagineering specification. Tr. 961-63; A9910, 9913-14. At retail, VK's dealers were "recommending VK from a[n] ... equal quality and similar design standpoint." A9906. Potential customers were told that VK is "comparable to [Imagineering]. But it was a third less" (Tr. 720) -- that the extra for [Imagineering] was just for "mystic or an allure." Tr. 721.

customer is going to be frustrated because any costs to repair it are going to be major because these plywood parts are structural parts of that settee. They're not just a slat or an arm, but they're the supporting aprons and supporting rails, so they're going to experience major costs to repair it.

* * *

Q. As it's sitting in the field deteriorating, is it possible one might think it's Weatherend furniture?

* * *

A. I would hope not. But due to the design, I would say yes.

See also Tr. 385-86. Customers, **in fact**, have imputed problems with VK to Imagineering, (Tr. 648-49), and VK products are currently deteriorating in the field even under optimum conditions. Tr. 221-22.

E. Trade Dress

In the District Court, VK argued, as it does here (Petition at 11, 29, 33), that Imagineering had not identified its trade dress and that its "furniture does not have a consistent overall look." As the District Court recognized, of course, it is complex to describe a "look" (A48-49) (citation omitted):

> [There are] difficulties inherent in relying upon mere words and phrases to describe the "total image of a product, which image may include features such as size, shape, color or color combinations, texture or graphics." To require that Imagineering describe its trade dress only in prose would run the risk, first, that the description might not adequately describe this "image," and, second, that defendants would be provided numerous opportuni-

ties to seek to evade the injunction's proscription by, for example, changing one aspect of a multi-faceted "image" and claiming that the trade dress, as defined, was not being infringed.

In product configuration cases, to indeed, defendants typically seek to compartmentalize and separately attack trade dress features, *see, e.g., LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76-77 (2d Cir. 1985), but as the predecessor to the Federal Circuit recognized:

> [Purchasers] do not engage in trademark dissection. Legal surgery, in which trademarks [and dress] have parts enhanced or discarded, is of little aid in determining the effect of design marks on purchasers who merely recollect. The scalpel is employed by lawyers, not purchasers.

Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 587 (C.C.P.A. 1973).

In properly focusing, therefore, on the "total image" created by Imagineering's trade dress, a review of the depictions of its pieces attached to the Permanent Injunction (A8-28) immediately reveals that the line is not a mere hodge-podge of unrelated pieces; to the contrary, there is a clear visual coherence in the use and spacing of slats, a substantial conformity in the configuration of arms and forelegs, and a predominance of soft curvatures. There is no "one identifying" feature, but "it's a combination of the tapered arms, contoured front leg[s], and the slatted back[s]." Tr. 260. As Imagineering's expert witness testified, the Imagineering "**line** is a very distinctive look.... [It] has a **harmonious line of furniture** which sets it apart from other manufacturers."

> Very often, you'll get a bench and maybe a table [but] with [Imagineering] they have many different ... kinds of pieces in their line so that you can use all the pieces in

> the same garden and **they work well together**. That was something I really appreciate about [Imagineering] furniture.

Tr. 843-44 (emphasis added). As Imagineering's president testified, "people do recognize our product, that it has a cohesive and overall look or appearance." Tr. 178-79. "[T]he [Imagineering] line has a consistency and single identity;" "there's a distinct overall appearance ... and thematic consistency." Tr. 308, 315. Imagineering advertises its furniture as an "innovative collection" (A9934, *et seq.*) of "36 gracefully sculptured pieces." *See* A4908.

VK, of course, understands full well the import of Imagineering's evidence: VK not only claimed that its look-alike line was distinctive (Tr. 1612), but it **advertised how well the various pieces work together**. *See, e.g.*, A10081, *et seq.* ("This sturdy and attractive high back chair fits well with all of our furniture." "The settee is usually the anchor for groupings of our furniture and blends well with all the furniture in our line." The round table "looks especially good accompanied by our chairs and 66" benches." "The coffee table is designed to be used with our chairs and settees" and the side chair "is very attractive standing alone or grouped with other pieces of our furniture.").[15] VK repeatedly referenced the "tapered arms" of its pieces and the "nautical look" of its chair crest rails (*id.*), and as cogent evidence of copying, one customer accepted a VK 60-inch table as a

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[15] While, therefore, VK is incorrect in asserting that the "overall appearance" of Imagineering's Isleboro table is "different" from Imagineering's Jackson chair (Petition at 11-12), the relevant point is that the chair and the table are totally compatible and "work well" together. The table also works well with other Imagineering pieces, *e.g.*, its quarter-circle settee (A15), and with curved benches not here at issue.

replacement for his Imagineering table to go with his existing Imagineering chairs. Tr. 1183-84.

Still further, to reiterate, trade dress "'may include features such as ... particular sales techniques,'" *Two Pesos,* 112 S. Ct. at 2755 n.1, and in this framework, the consistent image of both parties to this action extended beyond furniture designs to "solid Honduras mahogany," "West System epoxy ... developed for boat builders," and "AWLGRIP paint." *See* A10072-73; *compare* Tr. 33-34. Accordingly, there was overwhelming evidence as to both Imagineering **and** VK of "a consistent overall look" composed of both nonfunctional design elements and functional underlying components.

II. UNDER THE FACTS OF THIS CASE, THERE IS NO POSSIBLE CONFLICT BETWEEN PATENT AND TRADE DRESS LAW

If Imagineering's designs were generic and functional, such that affording them protection would impede competition, a conflict would exist between patent and trade dress law. Based, however, on a record of more than ten thousand pages, the Court of Appeals concluded that there was substantial evidence to the contrary. The premise for VK's argument is **factually** nonexistent.

In citing *Sears, Roebuck & Co. v. Stiffel Co.,* 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.,* 376 U.S. 234 (1964), for the **legal** proposition that there is an inherent tension between patent and trade dress law, VK ignores *Compco's* recognition that Congress may provide "other federal statutory protection" against the misappropriation of configurations potentially subject to design patents. *See* 376 U.S. at 238. VK also ignores thirty years of develop-

ment under just such a statute, culminating in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992), in which this Court implicitly extended protection under section 43(a) of the Lanham Act, 15 U.S.C. 1125(a), to "distinctive marks of all kinds, whether the claimed mark used distinctive words or symbols or **distinctive product designs.**" 112 S. Ct. at 2759 (emphasis supplied). In that thirty year period, courts have "consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property." *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 638 (7th Cir. 1993).

In this case, in keeping with this Court's application of section 43(a) in *Two Pesos*, Imagineering offered substantial evidence: (i) that its designs were inherently distinctive; and (ii) nonfunctional (that "competition [would] not be stifled by the exhaustion of a limited number of trade dresses");[16] and (iii) that there was a likelihood of confusion between its trade dress and VK's intentionally copied line. *See* 112 S. Ct. at 2761. Because this combination of facts is not a prerequisite for utility or design patent protection, there is not, and cannot be, a conflict between federal patent and trade dress law, or an impairment of competition, where the combination exists:

> Trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not "extend" the patent

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[16] Significantly, Imagineering offered substantial evidence of nonfunctionality, notwithstanding Second Circuit authority that functionality is an affirmative defense, with VK, and not Imagineering, bearing the burden of proof on the issue. *See LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985); *see also Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 863 (1982) (White, J., concurring) ("[F]unctionality is a defense to a suit under § 43(a) of the Lanham Act.").

monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other.

Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts, 944 F.2d 1235, 1240 (6th Cir. 1991) (quoting *In re Mogen David Wine Corp.,* 328 F.2d 925, 930 (C.C.P.A. 1964)), *cert. denied,* 112 S. Ct. 3028 (1992); *see also W.T. Rogers v. Keene,* 778 F.2d 334, 337 n.8 (7th Cir. 1985) ("The trademark owner has an indefinite term of protection, it is true, but in an infringement suit must also prove secondary meaning and likelihood of confusion, which the owner of a design patent need not do; there is therefore no necessary inconsistency between the two modes of protection."). Indeed, protection of distinctive, nonfunctional trade dress from confusingly similar copies "foster[s] competition and the maintenance of quality by securing to the producer the benefits of good reputation." *Two Pesos,* 112 S. Ct. at 2760. Without protection here, Imagineering's reputation would have been rapidly eroded by post-sale confusion with VK's substantially inferior products.

Accordingly, "*Sears* and *Compco* do not preclude a court from affording protection from infringement of a design element that has achieved secondary meaning and is nonfunctional, **notwithstanding the absence of a patent.**" *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.,* 685 F.2d 78, 81 (3d Cir. 1982) (emphasis added); *see also LeSportsac, Inc. v. K Mart Corp.,* 754 F.2d 71, 75 (2d Cir. 1985) ("[W]e have recognized that the design of a product itself may function as its packaging, serving to distinguish it from other products, and hence may be protectable trade dress under § 43(a)."). **Every Circuit to address this issue has resolved it against VK's position.** *See, e.g., Kohler v. Moen,* 12 F.3d at 638

(7th Cir.) (holding nonfunctional distinctive appearance of product entitled to trade dress protection); *accord Shakespeare Co. v. Silstar Corp.*, 9 F.3d 1091, 1092 (4th Cir. 1993), *cert. denied*, 114 S. Ct. 2134 (1994); *Ferrari v. Roberts*, 944 F.2d at 1239 (6th Cir.); *Bauer Lamp v. Shaffer*, 941 F.2d at 1168 (11th Cir.); *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 515 (9th Cir.), *cert. denied*, 493 U.S. 872 (1989); *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 516 (10th Cir. 1987); *Reader's Digest Ass'n v. Conservative Digest, Inc.*, 821 F.2d 800, 803-04 (D.C. Cir. 1987); *In re D.C. Comics, Inc.*, 689 F.2d 1042, 1045 (C.C.P.A. 1982); *Truck Equipment Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976). Entry of the relief requested by VK thus would necessitate the wholesale reversal of decades of well-established principles under the Lanham Act.[17]

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[17] Section 43(a) proscribes, of course, not only "any false designation of origin" that "is likely to cause confusion," but also any "misleading representation of fact" that "in commercial advertising or promotion, misrepresents the nature, characteristics [or] qualities" of goods, 15 U.S.C. § 1125(a), and there was a plethora of evidence that VK's materials misdescribed its construction techniques and components. *See, e.g.*, Tr. 757, 1576. Even, therefore, if this case did potentially present a conflict between patent and trade dress law, it would not be an appropriate candidate for review because the result below is wholly sustainable under proscriptions against false advertising: obviously, VK would not have taken business from Imagineering (*see* Tr. 221-22, 805-06) had VK truthfully revealed that its settees were "time bombs" constructed of "garbage wood" and waiting to disintegrate.

III. UNDER THE FACTS OF THIS CASE, THERE IS NO POSSIBLE CONFLICT BETWEEN PATENT LAW AND STATE UNFAIR COMPETITION LAW

If New York sought, under its laws of unfair competition, to protect designs irrespective **factually** of whether an article "could be made in some other way, [or whether] the design [was] 'nonfunctional' and not essential to use ..., [or whether] the configuration of the article [was inherently distinctive or] may have a 'secondary meaning' which identifies the maker to the trade, [or whether] there may be 'confusion' among purchasers," *Compco*, 376 U.S. at 238, then New York law would be preempted by federal patent law. Imagineering, however, offered substantial evidence as to every preemption exception enunciated in *Compco*, and VK's preemption argument is **factually** bereft of merit.

VK insists as a matter of **law** that Imagineering's damage recovery under New York unfair competition principles is nonetheless preempted because "Imagineering's alleged trade dress resides in the three dimensional design of its furniture" that is now ineligible for design patent protection. Petition at 23. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 154 (1989), however, this Court expressly observed:

> Trade dress is, of course, potentially the subject matter of design patents.... Yet our decision in *Sears* clearly indicates that the States may place limited regulations on the circumstances in which such designs are used to prevent consumer confusion as to source.

Quoting *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979), this Court went on to note that "[s]tate law is not displaced merely because the contract relates to intellectual property which may or may not be patentable; the states are

free to regulate the use of such intellectual property in any manner not inconsistent with federal law." 489 U.S. at 156.

In this framework, New York unfair competition law proscribes: (i) a bad faith misappropriation of plaintiff's labor and expenditures (ii) with an intention to benefit from its good will (iii) that creates likelihood of confusion. *Flexitized, Inc. v. National Flexitized Corp.*, 335 F.2d 774, 781 (2d Cir. 1964); *Centaur Communications v. A/S/M Communications*, 652 F. Supp. 1105 (S.D.N.Y.), *aff'd*, 830 F.2d 1217 (2d Cir. 1987); *Lincoln Restaurant Corp. v. Wolfey's Restaurant, Inc.*, 291 F.2d 302 (2d Cir. 1961). Any assertion that such purposes are **legally** at odds with patent law is so lacking in substance as to merit a frivolous label.

Factually, notwithstanding VK's continued insistence that "it did not" copy (Petition at 13), the evidence before the jury was overwhelming that:

1. VK's initial designs were, in fact, copied from Imagineering.

2. VK appreciated that the designs were distinctive.

3. VK was notified as to the illegality of its conduct before shipping its first piece of furniture.

4. Far from desisting, VK progressively extended its copying to Imagineering's rocking chair, quarter-circle settee and a host of other designs.

5. VK knew that its copies were causing confusion.

6. VK knew that its furniture was being substituted for Imagineering's in bidding contexts.

7. VK knew that its line was inadequately marked and that retail customers were being encouraged to choose its "cheaper [furniture] for the purpose of acquiring the prestige gained by displaying what many visitors ... would regard as

a prestigious article." *Mastercrafters Clock & Radio Co.*, 221 F.2d at 466; *see* Tr. 805-06.

8. Yet VK's sole response was to fabricate testimony to conceal the true source of its designs.

To suggest that states are helpless to prevent such conduct is to carry advocacy beyond acceptable limits.

CONCLUSION

The Petition for Ceritorari depends on factual predicates rejected by the jury. On the facts found by the jury, the Court of Appeals' decision was a proper application of trade dress law and is consistent with the rule in every Circuit to address the issue. Because the issues raised by the petition do not require the Court's attention, Respondent respectfully requests that the Court deny Petitioners' request for certiorari.

Respectfully submitted this 23d day of August, 1995,

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